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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/849,086	05/04/2001	Regina Johannesson	34650-00687USPT	9431

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EXAMINER
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BEAMER, TEMICA M

ART UNIT	PAPER NUMBER
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2681

DATE MAILED: 05/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/849,086

Applicant(s)

JOHANNESSON ET AL.

Examiner

Ternica M. Beamer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 November 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments filed 11/22/2004 have been fully considered but they are not persuasive.

Applicant argues that Nizri et al (Nizri) fails to disclose selecting a new PLMN to serve a mobile station from the PLMN's neighboring a PLMN currently serving the mobile station. The examiner, however, respectfully disagrees.

Nizri discloses a mobile terminal that stores a list of cells/PLMN's in which the mobile station can communicate in (0145, 0154, 0162, 0189). Nizri further discloses wherein the mobile station communicates with multiple PLMN's in the communication system (page 6, 0102) which inherently are adjacent to each other or at least within a certain distance of each other. Nizri also discloses wherein the mobile station can choose (based on information in the list stored in the mobile station) a new cell/PLMN to communicate with when suitable criteria are met (0142).

Therefore, Nizri reasonably discloses multiple PLMN's that can be stored in a mobile station and wherein the mobile station can communicate with the different PLMN's.

Based on the above remarks, the claims stand rejected as set for the below.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-4, 12-15, 19, 20, 26-29 and 31 are rejected under 35 U.S.C. 102(e) as being anticipated by Nizri et al (Nizri), U.S. Pub. No. 2002/197992.

Regarding claims 1, 13, 26 and 31, Nizri discloses a method/terminal/circuitry for selecting a public land mobile network to serve a mobile station comprising the steps of: receiving at the mobile station a list of data associated with networks neighboring a PLMN currently serving the mobile station (0181-0182); selecting a new PLMN to serve the mobile station from the PLMNs neighboring the PLMN currently serving the mobile station based upon the list of data; and changing the mobile station to the selected new PLMN (0141-0142).

Regarding claims 2 and 27, Nizri discloses the list of data further comprises a list of PLMNs neighboring the PLMN currently serving the mobile station (0142 and 0181).

Regarding claims 3, 14 and 28, Nizri discloses the list of data further comprises a list of PLMNs adjacent to the PLMN currently serving the mobile station (0107; figure 2).

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Regarding claims 4,15, and 29, Nizri discloses the list of data further comprises a list of PLMNs within a selected distance of the PLMN currently serving the mobile station (0107; figure 2).

Regarding claim 12, Nizri discloses the method of claim 1, further comprising the step of receiving a list of data in a MM information message (i.e., broadcast message) (Nizri, 0180-0181).

Regarding claim 19, Nizri discloses the method of claim 13, wherein the list of neighboring PLMN's further access technology (0017).

Regarding claim 20, Nizri discloses the method of claim 13, wherein the step of selecting further comprises the steps determining a better PLMN exists for serving the mobile station from the list of neighboring PLMNs; and scanning for the better PLMN (0010-0015).

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 5-7, 21-25 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nizri in view of Pinault et al (Pinault), U.S. Patent No. 5,809,416.

Regarding claims 5 and 30, Nizri discloses the method of claims 1 and 26 as described above and further discloses wherein a neighbor list broadcast to a mobile station can include location area information (0181) . Nizri, however, fails to disclose wherein the location area comprises at least one mobile country code associated with a network neighboring the PLMN currently serving the mobile station.

In a similar field of endeavor, Pinault discloses a device for seeking connection of a terminal to a network of a mobile radio system comprising a plurality of networks. Pinault further discloses wherein the location area information comprises at least one mobile country code associated with a network neighboring a PLMN currently serving the mobile station (col. 4, line 61-col. 5, line 10).

At the time of invention, it would have been obvious to a person of ordinary skill in the art to modify Nizri with the teachings of Pinault for the purpose allowing a user of the terminal to know which country they are in. Such a feature could help the user in knowing which features or services he/she could or could not use.

Regarding claim 6, the combination of Nizri and Pinault discloses the method of claim 5 wherein the step of selecting further comprises the step of: determining if the at least one mobile country code is associated with a preferred PLMN of the mobile station; and selecting the preferred PLMN of the mobile station as the new PLMN if the mobile country code is associated with the preferred PLMN (Pinault, col. 4, line 61-col. 5, line 10).

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Regarding claim 7, the combination of Nizri and Pinault discloses the method of claim 5, wherein the preferred PLMN comprises a home PLMN of the mobile station (Pinault, col. 4, lines 61-64).

Regarding claim 21, Nizri discloses a method for selecting a preferred PLMN to a serve a mobile station, comprising the steps of transmitting from a base station associated with a serving PLMN to the mobile station, location area information associated with a neighboring network (0081, 0115, 0180); selecting the preferred PLMN as a new serving PLMN (0141, 0142) if the at least location area is associated with the preferred PLMN (i.e., a PLMN that's not on a forbidden list) (0154), scanning for the preferred PLMN and changing the mobile station to the preferred PLMN (0141, 0142).

Nizri, however, fails to disclose wherein the location area information is a country code.

Pinault further discloses this information (col. 4, line 61-col. 5, line 10).

At the time of invention, it would have been obvious to a person of ordinary skill in the art to modify Nizri with the teachings of Pinault for the purpose allowing a user of the terminal to know which country they are in. Such a feature could help the user in knowing which features or services he/she could or could not use.

Regarding claim 22, the combination of Nizri and Pinault discloses the method of claim 22 wherein the step of selecting further comprises the step of: determining if the at least one mobile country code is associated with a preferred PLMN of the mobile station; and selecting the preferred PLMN of the mobile station as the new PLMN if the

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mobile country code is associated with the preferred PLMN (Pinault, col. 4, line 61-col. 5, line 10).

Regarding claim 23, the combination of Nizri and Pinault discloses the method of claim 21, further comprising the step of receiving a list of data in a MM information message (i.e., broadcast message) (Nizri, 0180-0181).

Regarding claim 24, the combination of Nizri and Pinault discloses the method of claim 21, wherein the preferred PLMN comprises a home PLMN of the mobile station (Pinault, col. 4, lines 61-64).

Regarding claim 25, the combination of Nizri and Pinault discloses the method of claim 21 as described above and further discloses broadcasting a neighbor list to a mobile station (Nizri, 0180, 0181). The combination, however, fails to particularly teach where and how often to broadcast the list.

However, the examiner believes that the above limitation would not render the claims patentable over the applied references because it merely depends on where and how often one would like to broadcast the list, without changing the scope of the invention in the applied references. Therefore, it would have been obvious to a person of ordinary skill in the art at the time of invention, to broadcast the system list at various locations or times in order to have flexible and various ways of broadcasting the system list to the mobile station.



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6. Claims 8-11 and 16-18 rejected under 35 U.S.C. 103(a) as being unpatentable over Nizri.

Regarding claims 8-11 and 16-18, Nizri discloses the method of claims 1 and 13 as described above. Nizri, however, fails to disclose where and how often to broadcast the above list as recited in the claims. However, the examiner believes that the above recitations would not render the claims patentable over the applied references because they merely depend on where and how often one would like to broadcast the list, without changing the scope of the invention in the applied references. Therefore, it would have been obvious to a person of ordinary skill in the art at the time of invention, to broadcast the system list at various locations or times in order to have flexible and various ways of broadcasting the system list to the mobile station.

### ***Conclusion***

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Temica M. Beamer whose telephone number is (571) 272-7797. The examiner can normally be reached on Monday-Thursday (alternate Fridays) 7:00am-4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on (571) 272-3865. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

April 27, 2005

Temica M. Beamer  
Primary Examiner  
Art Unit 2681

A handwritten signature in black ink that reads "Temica M. Beamer". The signature is written in a cursive style with a large initial "T" and "B".

**TEMICA BEAMER  
PRIMARY EXAMINER**